

Appl. No. 10/622,954
Amdt. Dated Sep. 23, 2004
Reply to Office Action of Jun. 23, 2004

REMARKS

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, Examiner states that the printed circuit board must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Applicant respectfully traverses this objection because the printed circuit board (4) has been shown in FIG. 1 of the present application. Furthermore, the printed circuit board (4) is referenced in para. [0020] on p.7 of the specification as originally filed.

Accordingly, applicant asserts that the claims of the present invention are completely disclosed in the drawings and the specification, and that there is no need to amend the drawings or cancel the printed circuit board from the claims.

The drawings are also objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference character(s) mentioned in the description: 234 on page 7.

In response to this objection, applicant has amended the specification to remove all mentions of the reference character 234, and has amended the text of the specification accordingly. Applicant has amended in this manner in order to avoid making amendments to the drawings. Applicant submits that the objection is now overcome.

Claim Rejection under 35 U.S.C 112

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Claims 8-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Examiner states that claims 8-10 include the printed circuit board, which has not been shown in the drawings; therefore the structural relationship between elements cannot be positively established.

Applicant refers to his above assertions that the specification and the drawings clearly disclose the printed circuit board. Accordingly, applicant submits that claims 8-10 of the present invention are clear and distinct, and requests that the rejection be withdrawn.

Further, applicant advises that claims 8-10 have been amended in respect of minor grammatical errors, omissions and inconsistencies only. Applicant requests that claims 8-10 be allowable, in accordance with Examiner's comments under Allowable Subject Matter in the Office action.

Claim Rejection under 35 U.S.C 103

Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Varghese et al.

The basis of this rejection is that Varghese discloses a spacer 60 comprising a base 62 made of electrically and thermally conductive material having a plurality of venting holes 64, a plurality of posts 82 each defining a press-fit hole therein, and a plurality of protrusions 62a benefiting air flow. Examiner further states that Varghese discloses the claimed invention except transceiver modules and aluminum and die-cast materials. Examiner concludes that it would have been

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obvious at the time the invention was made to a person having ordinary skill in the art to use the structure as disclosed by Varghese for transceiver modules since it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2USPQ2d 1647 (1987). Examiner further states that it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice: In re Leshin, 125 USPQ 416.

Applicant respectfully traverses this rejection for the following reasons.

Firstly, claim 1 of the present invention relates to transceiver module shielding cages, whereas the object of Varghese is to provide hard disk drive support. These different objectives result in different structures, as detailed below.

Secondly, Varghese discloses a spacer [i.e. disk drive shock reducing assembly] 60 comprising side edge portions 62a. Applicant submits that the side edge portions 62a of Varghese cannot reasonably be equated with the claimed "protrusions" of the present invention. In particular, the side edge portions 62a are unitary peripheral portions, unlike the discontinuous non-peripheral protrusions of the present invention. There is no teaching or suggestion in Varghese that the side edge portions 62a benefit air flow. Rather, the side edge portions 62a are provided as a means for enabling a tray structure 38 to be slid into the interior of a cage 16 (col. 6, lines 7-14), and as a means for compensating dimensional inaccuracies in guide channel members and reducing or eliminating "play" (col. 6, line 46-59).

Thirdly, claim 1 of the present invention recites a spacer which comprises at least a hole and at least one conductive passageway, both of which benefit air flow.

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The present invention provides a simple spacer which greatly facilitates air flow therethrough, and which is not reasonably derivable from a consideration of Varghese.

Double Patenting

Claims 8-10 are rejected under the judicially created doctrine of double patenting over claims 1-3 of U.S. Patent No. 6,731,519, since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

Examiner states that the subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent, since the patent and the application are claiming common subject matter as follows: an upper and lower shielding cages having a spacer, and dividing walls with protrusions all being installed in a stacked arrangement.

Examiner further states that there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *in re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Applicant respectfully traverses this double patenting rejection.

Claim 8 defines "*the upper cage and the lower cage being shorter than the at least one upper dividing wall and the at least one lower dividing wall in the front-to-back direction*". This arrangement specifically makes it convenient to have the upper dividing wall and the lower dividing wall directly interengaged with each other (via protrusions 257, 237, FIGS. 4 and 5) around a rear portion of the shielding cover.

Differently, claims 1-3 of U.S. Pat. No. 6,731,519 do not define these limitations.

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Similarly, claim 10 defines "*the upper cage and the lower cage being shorter than the shielding cover in the front-to-back direction*".

Differently, claims 1-3 of U.S. Pat. NO. 6,731,519 do not define these limitations.

Accordingly, it is believed that there is no double patenting issue. Removal of the double patenting rejection is respectfully requested.

In view of the foregoing, the subject application as claimed in the pending claims is believed to be in a condition for allowance subject to the filing of a terminal disclaimer, and an action to such effect is earnestly solicited.

Respectfully submitted,
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